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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,012	09/15/2003	Jiann-Chen Chen	81439/LPK	2748
7590	09/23/2005			
Lawrence P. Kessler NexPress Solutions LLC Patent Department 1447 St. Paul Street Rochester, NY 14653-7103			EXAMINER JIMENEZ, MARC QUEMUEL	
			ART UNIT	PAPER NUMBER
			3726	
DATE MAILED: 09/23/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,012

Applicant(s)

CHEN ET AL.

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18 is/are allowed.
- 6) ☒ Claim(s) 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 19 is objected to because of the following informalities: “fill” in line 3 should be - - fit - -. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 19 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art [AAPA] (the preamble of claim 19) in view of Chen et al. (US5716714).

The preamble of claim 19 is written in Jepson format where the limitations in lines 1-7 before “improvement comprising” is considered admitted prior art. MPEP 2129 III. *JEPSON* CLAIMS states: “Drafting a claim in *Jepson* format (ie., the format described in 37 CFR 1.75(e); see MPEP 608.01(m)) is taken as an implied admission that the subject matter of the preamble is the prior art work of another. *In re Fout*, 675 F.2d 297, 301, 213 USPQ 532, 534 (CCPA 1982)...”.

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Therefore, positioning a primer consisting essentially of a silane coupling agent containing epoxies on the outside of the sleeve to thereby improve adhesion of the base cushion elastomer to the outside of the sleeve is considered the improvement.

However, Chen et al. teach that it is known to use a suitable primer material including silane coupling agents (col. 4, lines 23-24) to bond a core that can be made of nickel alloys (col. 3, lines 23-24) to an elastomer layer.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of [AAPA] with the steps of positioning a primer consisting essentially of a silane coupling agent containing epoxies on the outside of the sleeve, in light of the teachings of Chen et al., in order to securely fasten the nickel material to the elastomer material.

4. **Claims 19 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jiann H. Chen et al. (US6696158) in view of Hoffman et al. (US 2002/0002921A1) and Jiann H. Chen et al. (US5716714).

Chen et al. ('158) teach a high temperature sleeve **16** having an inner diameter adapted to closely fit around an outer diameter of a mandrel in an electrophotographic machine fuser section, a base cushion elastomer (col. 8, lines 62-67) layer **14** around an outside of the sleeve **16**, a primer (col. 9, line 58-60) positioned on the outside of the sleeve **16** to provide bonding between the base cushion **14** and the sleeve **16**, and a layer **12** of cured thermoplastic polymer selected from the group consisting of thermoplastic polyfluorocarbon polymers (col. 5, lines 50-

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51) and thermoplastic polyfluorocarbon random copolymers around the outside of the base cushion 14.

Chen et al. ('158) teach the invention cited with the exception of the sleeve being made of nickel and the primer consisting essentially of a saline coupling agent containing epoxies.

Hoffman et al. teach that it is known to use either steel, aluminum, or nickel sleeves (paragraph [0024], lines 2-3 and paragraph [0037] last three lines).

Chen et al. ('714) teach that it is known to use a suitable primer material including silane coupling agents (col. 4, lines 23-24) to bond a core that can be made of nickel alloys (col. 3, lines 23-24) to an elastomer layer.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Chen et al. with a nickel sleeve, in light of the teachings of Hoffman et al., in order to

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have replaced the "stainless steel, steel, aluminum, etc." sleeve (col. 5, lines 14-15) of Chen et al. ('158) with a sleeve made of nickel, in light of the teachings of Hoffman et al., in order to provide a sleeve material that can withstand high temperatures and is suitably rigid.

Furthermore, it is noted that Hoffman et al. suggest that the sleeve could be made of any suitable metal such as those described in paragraphs [0024] and [0037]. Therefore, because the types of materials Chen et al. describes in col. 5, lines 14-15 and the materials described by Hoffman et al. were art-recognized equivalents at the time of the invention was made, one of ordinary skill in the art would have found it obvious to substitute the sleeve materials described by Chen et al. for the nickel material described by Hoffman et al.

Furthermore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Chen et al. ('158) with a primer consisting essentially of a saline coupling agent containing epoxies, in light of the teachings of Chen et al. ('714), in order to provide a primer that can easily bond with metal such as nickel described in col. 3, lines 23-24. It is noted that Chen is the same inventor in both the '714 and '158 patents and therefore one of ordinary skill in the art, at the time of the invention, would have found it obvious to substitute a particular type of primer with a silane coupling agent as claimed.

Allowable Subject Matter

5. Claims 1-18 are allowed.

Response to Arguments

6. Applicant's arguments with respect to claims 19 and 20 have been considered but are moot in view of the new ground(s) of rejection.

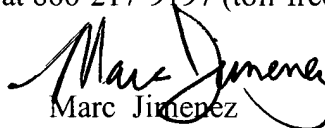
Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (571) 272-4530. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Marc Jimenez
Primary Examiner
Art Unit 3726

MJ
8/9/05